

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRETT A. GREEN

Appeal No. 2007-1271
Application No. 10/005,583
Technology Center 2100

Decided: June 12, 2007

Before LEE E. BARRETT, JOSEPH F. RUGGIERO, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1-24. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

It is our view, after consideration of the record before us, that the evidence relied upon supports the Examiner's rejection of claims 1, 6-9, 12, 13, 16, and 21-23, but does not support the Examiner's rejection of claims 2-5, 10, 11, 14, 15, 17-20, and 24. Accordingly, we AFFIRM-IN-PART. In addition, we have *sua sponte* set forth new grounds of rejection for independent claim 17 pursuant to our authority under 37 C.F.R. § 41.50(b).

THE INVENTION

The disclosed invention generally relates to a browser-controlled scanning system and method. More particularly, the disclosed invention relates to a system and method in which the operation of a scanning device is controlled from a browser such that documents are scanned and, where desired, optical character recognition is performed on the scanned documents for subsequent display to the user with a browser (Specification 1).

The appeal contains claims 1-24. Claims 1, 9, 13, and 17 are independent claims. Claims 1 and 17 are illustrative:

1. A method for scanning a document, comprising:
receiving a scan request from a user browser;
uploading content to the user browser;
receiving selections made with the user browser; and
scanning the document in accordance with the user selections.
17. A scanning device, comprising:
a processing device;
scanning hardware; and
memory comprising a scan control module and an embedded server,
the scan control module comprising a scanning module and an optical

character recognition module, the scan control module further including logic for generating at least one control screen that can be uploaded to a user browser.

THE REFERENCES

The Examiner relies upon the following references as evidence of anticipation and obviousness:

Dance	US 2002/0076111 A1	Jun. 20, 2002
Somashekar	US 2002/0116477 A1	Aug. 22, 2002
Kuwata	US 2003/0072031 A1	Apr. 17, 2003

THE REJECTIONS

Appellant seeks our review of the following rejections:

1. Claims 1-3, 6, 9, 11, 13, 15, and 21-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kuwata.
2. Claims 4, 5, 7, 8, 12, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuwata in view of Dance.
3. Claims 10 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuwata in view of Somashekar.
4. Claims 17-20, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuwata in view of Dance, and further in view of Somashekar.

ISSUES

The principal issues before us are whether Appellant has shown the Examiner erred in rejecting claims 1-3, 6, 9, 11, 13, 15, and 21-23 based on anticipation, and whether the Examiner erred in rejecting claims 4, 5, 7, 8, 10, 12, 14, 16-20, and 24 based on obviousness.

More particularly, we decide the following issues we have determined are dispositive in deciding this appeal:

1. Whether Kuwata discloses receiving a scan request from a user browser.
2. Whether Kuwata discloses receiving selections made with the user browser.
3. Whether Kuwata discloses uploading a control screen to the user browser.
4. Whether Kuwata discloses uploading an application to the user browser.
5. Whether Kuwata discloses the receiving, uploading, and scanning are all performed by a scanning device.
6. Whether or Dance or Somashekar teaches or suggests uploading a control screen to a user browser.
7. Whether a person of ordinary skill in the art having common sense at the time of the invention would have been motivated to employ Somashekar's embedded server in Kuwata's system given that Kuwata's scanning control component is an actual server.

FINDINGS OF FACT

At the outset, we note that the Examiner's factual findings are not in dispute except with respect to the specific claim limitations argued by Appellant in the Briefs. Only those arguments actually made by Appellant have been considered in this decision. With respect to the anticipation rejection (Kuwata), we note that anticipation is a question of fact. *See*

Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, 45 F.3d 1550, 1554, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995) (internal citations omitted).

For each of issues 1-5, we make the following findings of fact with respect to the Kuwata reference:

1. We find Kuwata discloses receiving a scan request from a user browser (*See Analysis infra*).
2. We find Appellant has admitted in the Reply Brief (p. 3, ¶ 2, ll. 4-5) that Kuwata discloses receiving selections made with a user browser (*See Analysis infra*).
3. We find Kuwata does not disclose uploading a control screen to a user browser (*See Analysis infra*).
4. We find Kuwata does not disclose uploading an application to a user browser (*See Analysis infra*).
5. We find Kuwata discloses a scanning device that performs the functions of receiving, uploading, and scanning (*See Analysis infra*).

With respect to the Examiner's obviousness rejections, we note that the ultimate issue of obviousness is a matter of law that turns on four underlying factual determinations: (1) the scope and content of the prior art, (2) the level of ordinary skill in the art, (3) the differences between the claimed invention and the prior art, and (4) objective indicia of nonobviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), as reaffirmed by *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1391 (2007).

For Issue 6, we make the following finding of fact with respect to the scope and content of the prior art and the differences between the claimed invention and the prior art:

6. We find that Somashekar teaches and/or suggests uploading a control screen to a user browser (*See Analysis infra*).

MATTERS OF LAW (Obviousness)

7. For issue 7, we conclude that a person of ordinary skill in the art having common sense at the time of the invention would not have been motivated to employ Somashekar's embedded server in Kuwata's system in the manner suggested by the Examiner given that Kuwata's scanning control component is an actual server (*See Analysis infra*).

STATEMENT OF LAW (Anticipation)

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharm.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992)). Anticipation of a patent claim requires a finding that the claim at issue "reads on" a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed Cir. 1999) ("In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless

of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

STATEMENT OF LAW (Obviousness)

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

ANALYSIS

Issue 1:

1. We decide the question of whether Kuwata discloses receiving a scan request from a user browser.
 - a. Appellant argues that Kuwata does not disclose the recited step of “receiving a scan request from a user browser” (Br. 8).

b. The Examiner disagrees. The Examiner argues that Kuwata's server functions as a document scanner and is accessible by utilizing a browser (Figure 3; p.1, ¶ 8). Therefore, the Examiner concludes that Kuwata discloses a scan request is made using a browser to operate the server (Answer 12).

With respect to issue 1, we agree with the Examiner that Kuwata's server functions as a document scanner that is accessible by utilizing a browser. In particular, we find that Kuwata explicitly discloses: "the invention contemplates a client server based system wherein the server is accessible by the client across a network, preferably the Internet, utilizing a browser" (Kuwata, p. 1, ¶ 0008). Kuwata further discloses: "[a]dditionally, the server may also function as a document scanner" (*id.*). Thus, we find the client (i.e., a requester of services) must inherently send a request to the server (i.e., a provider of services) to *access* the server, which, as disclosed by Kuwata, "may also function as a document scanner" (*id.*). Therefore, given the breadth of Kuwata's disclosure, we find the weight of the evidence supports the Examiner's position.

Issue 2:

2. We decide the question of whether Kuwata discloses receiving selections made with a user browser.

With respect to issue 2, we find Appellant has admitted in the Reply Brief that Kuwata discloses receiving selections made with a user browser (*See* Reply Brief, p. 3, ¶ 2, ll. 4-5, i.e., "Applicant agrees [with respect to Kuwata] that selections are made with a browser when a user accesses scanned documents.").

Issue 3:

3. We decide the question of whether Kuwata discloses uploading a control screen to a user browser.
 - a. Appellant argues that Kuwata does not disclose uploading content to a user browser in the form of at least one control screen (Br. 12).
 - b. The Examiner disagrees. The Examiner argues that Kuwata discloses different folders shown to users based upon their registration. The Examiner notes that for registered users, the “Public” and “private” folders are shown, while for an Administrator the “DEPARTMENT” folder is shown in addition to the Public and private folders (*see* Kuwata, ¶ 0047). Therefore, the Examiner finds Kuwata discloses content that is uploaded based on user registration before the scanning occurred (Answer 14).

With respect to issue 3, we agree with Appellant that Kuwata does not disclose *uploading* content to a user browser in the form of *at least one control screen*. While we agree with the Examiner that user registration or Administrator status permits various levels of access, we find nothing in the cited portion of Kuwata that may be reasonably characterized as an express or inherent teaching of *uploading a control screen to a user browser*. Our further review of the entire Kuwata reference finds no disclosure to support the Examiner’s position.

Issue 4:

4. We decide the question of whether Kuwata discloses uploading an application to a user browser.

- a. Appellant argues that Kuwata does not disclose uploading an application to the user browser. Appellant argues that paragraph 0053 pointed to by the Examiner merely describes enabling extra tabs or buttons on the web browser used by the system administrator (Br. 12).
- b. The Examiner disagrees. The Examiner argues that enabling tabs and buttons when an Administrator logs in comprises an application since an Administrator user is allowed to access and manage all folders and files (*see* Kuwata ¶ 0053) (Answer 19).

With respect to issue 4, we agree with Appellant that Kuwata does not disclose *uploading* an application to the user browser. While we agree with the Examiner that the software that enables tabs and buttons in the web browser used by the Administrator comprises an application, we nevertheless find nothing in the cited portion of Kuwata (*see* ¶ 0053) that expressly or inherently teaches *uploading* at least one user application to a computing device on which the browser runs. Our further review of the entire Kuwata reference finds no disclosure to support the Examiner's position.

Issue 5:

5. We decide the question of whether Kuwata discloses the receiving, uploading, and scanning are all performed by a scanning device.
 - a. Appellant argues that although the component that actually performs the scanning is not identified by Kuwata, presumably the scanning is performed by a *separate scanner* that is connected to the server. Appellant argues that a person of ordinary skill in the art would know that a server is not a scanning device (Br. 13).

- b. The Examiner disagrees. The Examiner argues that Kuwata discloses that the server functions as a document scanner (*see* Kuwata, p. 1 ¶ 0008) (Answer 15, ¶ 2).

With respect to issue 5, we note, e.g., that the language of dependent claim 21 (i.e., “wherein the receiving, uploading, and scanning are all performed by a scanning device”) further limits the language of independent claim 1. Thus, claim 21 requires that the receiving, uploading, and scanning steps of claim 1 are performed by a *scanning device*. We note again that Appellant has admitted in the Reply Brief that Kuwata discloses *receiving selections made with the user browser* when the user accesses scanned documents (*see* discussion of Issue 2; *see also* claim 1; *see also* Reply Brief, p. 3, ¶ 2, ll. 4-5). We also find Appellant has admitted in the Brief that Kuwata’s “scanning control component is an actual server” (*see* Brief, p. 17, ¶ 2, l. 3). Therefore, when the language of claim 21 is read as a further limitation of claim 1, we find that receiving selections (i.e., scanned content) with the user browser (as admitted by Appellant) corresponds to uploading *content* to the user browser *from the perspective of Kuwata’s server* (as opposed to uploading from the server a *control screen* or an *application* to the user browser that we have found *supra* is not disclosed by Kuwata). We again point out that Kuwata discloses “the server may also function as a document scanner” (p. 1, ¶ 0008). Thus, we find the weight of the evidence supports the Examiner’s finding that Kuwata discloses a scanning device (i.e., a server that functions as a document scanner) that performs the recited receiving, uploading, and scanning steps.

Issue 6:

6. We decide the question of whether Dance or Somashekar teaches uploading a control screen to a user browser (*see* claims 10, 14, and 17).
 - a. Appellant argues that Somashekar does not remedy the deficiencies of Kuwata (Br. 17, *see* claims 10 and 14).
 - b. The Examiner disagrees. The Examiner relies upon Kuwata as teaching the uploading of a control screen to a user browser (Answer 22-23).

With respect to issue 6, we have found *supra* that nothing in Kuwata may be reasonably characterized as an express or inherent teaching of *uploading a control screen to a user browser*. After carefully reviewing the entirety of the Dance reference (relied upon by the Examiner as teaching an Optical Character Recognition (OCR) capability), we likewise find no express nor inherent teaching of *uploading a control screen to a user browser*. However, we find that Somashekar teaches and/or suggests loading (i.e., uploading) a control screen (i.e., a new version of a controlling service) to a web browser (such as a web browser executing on a PDA or Web phone), as follows:

[0007] Embedded applications run on microcomputers that are embedded within electronic devices such as appliances, vending machines, gasoline pumps, cellular phones, or pagers. Embedded systems are also being used to develop a new line of sophisticated devices such as personal data assistants (PDAs), smart pagers, and Web phones. The latest Web phones now support a variety of useful services, such as an address book, an auto-dialer, an *Internet browser*, and a calendar [emphasis added].

[0008] Although memory is not quite as scarce as it once was, embedded systems still have limited local memory resources. Only so much space is available for pre-installed services. But if services can be loaded on demand, then a small microprocessor can become a much more versatile computing system. Where once a device could perform only one or two operations, now it can perform a wide variety of operations. This approach to embedded services simplifies management of the devices. The services can be maintained and administered in a centralized location, and can be delivered via the network as required. Users are no longer required to replace the entire device in order to upgrade to new services or capabilities. *They simply load a new version of the controlling service* [emphasis added].

(Somashekar, ¶¶ 0007, 0008, *see also* Figs. 4 and 5).

Therefore, with respect to issue 6, we find Somashekar teaches and/or suggests uploading a control screen to a user browser.

Issue 7:

7. We decide the question of whether a person of ordinary skill in the art having common sense at the time of the invention would have been motivated to employ Somashekar's embedded server in Kuwata's system given that Kuwata's scanning control component is an actual server.

a. Appellant argues that there is no reason why a person of ordinary skill in the art would have been motivated to employ an embedded server in Kuwata's system given that Kuwata's scanning control component is an actual server (Br. 17, ¶ 2). In the Reply Brief, Appellant argues that no person having ordinary skill in the art would reasonably think to embed a server within a server (Reply Brief 8, ¶ 1).

b. The Examiner disagrees. The Examiner argues that it would have been obvious to one of ordinary skill in the art to combine the teachings of Kuwata and Somashekar, since Kuwata teaches a server that uploads an Administrator application to manage files, folders, users, and scanned documents (*see* Kuwata, p. 3, ¶¶ 0047, 0053). The Examiner further points to Somashekar's teaching of an embedded server that performs the functions of loading, installation, activation, execution and removal of services and components (*see* Somashekar, p.1, ¶ 0010). The Examiner proffers that Somashekar's embedded server could handle the functions of loading applications, enabling and removing services (such as those given to an Administrator) if incorporated into Kuwata's electronic document system. The Examiner further notes that Somashekar offers the advantages of an embedded server that enables services to be maintained and administered at a central location which simplifies the management of devices (*see* Somashekar, p.1, ¶ 0008) (Answer 25-26).

With respect to issue 7, we find the problem proffered by the Examiner is already solved by Kuwata's server that functions as a scanner (*see* Kuwata p. 1, ¶ 0008). We note that the U.S. Supreme Court recently reaffirmed that "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon *ex post* reasoning." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1397. *See also Graham v. John Deere Co.*, 383 U.S. at 36, 148 USPQ at 474. Nevertheless, in *KSR* the Supreme Court also qualified the issue of hindsight by stating that "[r]igid preventative rules that deny factfinders

recourse to common sense, however, are neither necessary under our case law nor consistent with it.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1397. Here, we agree with Appellant that a person of ordinary skill in the art would not have reasonably looked to Somashekar to provide a server capability that was already provided by Kuwata. In the record before us, we find only the language of the instant claims suggests such a combination (*see* claims 10, 14, and 17). Therefore, we conclude that an artisan *having common sense* at the time of the invention would not have reasonably considered embedding a server within an existing server in the manner suggested by the Examiner.

MAPPING OF ISSUES TO SPECIFIC CLAIMS

Independent claims 1, 9, and 13

We note that the patentability of independent claims 1, 9, and 13 turns upon our findings of fact with respect to Issues 1 and 2. Because we have found that the weight of the evidence supports the Examiner’s position on Issues 1 and 2, we will sustain the Examiner’s rejection of independent claims 1, 9, and 13.

Dependent claim 2

We note that patentability of dependent claim 2 turns upon our finding of fact with respect to Issue 3. Because we have found *supra* that the weight of the evidence supports Appellant’s position with respect to Issue 3, we will reverse the Examiner’s rejection of dependent claim 2 as being anticipated by Kuwata.

Dependent claims 3-5, 11, and 15

We note that patentability of dependent claims 3, 11, and 15 turns upon our finding of fact with respect to Issue 4. Because we have found that the weight of the evidence supports Appellant's position with respect to Issue 4, we will reverse the Examiner's rejection of dependent claims 3, 11, and 15 as being anticipated by Kuwata. Because claims 4 and 5 each depend upon claim 3, we will also reverse the Examiner's rejection of claims 4 and 5 as being unpatentable over Kuwata in view of Dance.

Dependent claim 6

We note that patentability of dependent claim 6 turns upon our finding of fact with respect to Issue 5. Because we have found that the weight of the evidence supports the Examiner's position with respect to Issue 5, we will sustain the Examiner's rejection of dependent claim 6 as being anticipated by Kuwata.

Dependent claims 21-23

We note that patentability of dependent claims 21-23 turns upon our finding of fact with respect to Issue 5. Because we have found *supra* that the weight of the evidence supports the Examiner's position with respect to Issue 5, we will sustain the Examiner's rejection of dependent claims 21-23 as being anticipated by Kuwata.

Independent claim 17

We note that the patentability of independent claim 17 turns upon our conclusion of law with respect to Issue 7 (obviousness). Because we have found that the weight of the evidence supports Appellant's position with

respect to Issue 7, we will reverse the Examiner's rejection of independent claim 17.

Dependent claims 18-20 and 24

Because claims 18-20 and 24 each depend upon independent claim 17, we will also reverse the Examiner's rejection of claims 18-20 and 24 as being unpatentable over Kuwata in view of Dance, and further in view of Somashekar.

Dependent claims 7, 8, 12, and 16

We note that Appellant has not presented any substantive arguments directed separately to the patentability of dependent claims 7, 8, 12, and 16 (*See* Br. 16). A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2004). In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). Therefore, we will sustain the Examiner's rejection of claims 7, 8, 12, and 16 as being unpatentable over Kuwata in view of Dance for the same reasons discussed *supra* with respect to independent claims 1, 9, and 13 as being anticipated by Kuwata.

Dependent claims 10 and 14

We note that the patentability of dependent claims 10 and 14 turns upon our conclusion of law with respect to Issue 7 (obviousness). Because we have found that the weight of the evidence supports Appellant's position with respect to Issue 7, we will reverse the Examiner's rejection of

dependent claims 10 and 14 as being unpatentable over Kuwata in view of Somashekar.

CONCLUSIONS OF LAW

Anticipation

On the record before us, we find Appellant has not shown the Examiner failed to establish a prima facie case of anticipation for each of claims 1, 6, 9, 13, and 21-23. However, we find that Appellant has shown the Examiner failed to establish a prima facie case of anticipation for each of claims 2, 3, 11, and 15.

Obviousness

On the record before us, we conclude that Appellant has not shown the Examiner failed to establish a prima facie case of obviousness for each of claims 7, 8, 12, and 16. However, we conclude that Appellant has shown the Examiner failed to establish a prima facie case of obviousness for each of claims 4, 5, 10, 14, 17-20, and 24.

NEW GROUNDS OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we have *sua sponte* set forth new grounds of rejection for independent claim 17.

Independent claim 17

Claim 17 is rejected under 35 U.S.C. § 102(e) as being anticipated by James et al. (U.S. Pat. 6,742,161, issued May 25, 2004, filed Mar. 7, 2000). We find independent claim 17 broadly but reasonably reads on James, as follows:

Independent Claim 17

James (U.S. Pat. 6,742,161)

17. A scanning device, comprising:	<i>see</i> Document Scanner 107, col. 4, ll. 2-3, col. 5, l. 1, Figs. 1, 2.
a processing device;	<i>see</i> Computer 100, col. 3, l. 51-66, Fig. 1.
scanning hardware; and	<i>see</i> Document Scanner 107, col. 4, ll. 2-3, col. 5, l. 1, Figs. 1, 2.
memory comprising,	<i>see</i> RAM 118, ROM 120, Disk 122, col. 3, ll. 55-58, Fig. 1.
a scan control module and	<i>see</i> scanner application 212, ll. 60-62, Fig. 2.
an embedded server	<p>We broadly construe a server as a provider of services. <i>See</i> col. 5, ll. 60-62, i.e., “As noted previously, the function of the scanner interface application 212 may also be embedded within the web browser, for example.”</p> <p><i>see also</i> Fax Server 216 (i.e., a server embedded within a device), Email Server 219, Network Server 218, Routing Server 217, Handwriting Recognition Server 226, LST Server 228, and Rendering Server 230, as shown in Fig. 2. <i>See also</i> Application Server 222, col. 7, ll. 8-19).</p>
the scan control module comprising a scanning module and	<i>see</i> scanner application 212, col. 5, ll. 45-67, Fig. 2.
an optical character recognition module,	<i>see</i> OCR server 224, Fig. 2, col. 7, ll.
the scan control module further including logic for generating at least one control screen that <i>can be</i> uploaded to a user browser [emphasis added].	<p><i>see</i> scanner application 212, col. 5, ll. 45-67, Fig. 2.</p> <p><i>see</i> col. 4, l. 65 through col. 5, l. 5, i.e., “If the document to be</p>

	<p>transmitted to the remote processing site 206 is a paper document, it will need to be scanned into an electronic file before transmission, <i>for example by using the scanner 107. To facilitate such an operation, it may be desirable to incorporate scanner controls within the browser, which may be displayed as buttons within the browser window.</i> The function and purpose of such scanner controls are described hereinafter” [emphasis added].</p> <p><i>see also col. 4, ll. 46-59, i.e., “In the OCR processing embodiment, for example, various source programs may be used to submit a document for recognition. One example is a web browser 208, which may be used to submit a document for processing and to receive a processed document, as indicated by the bidirectional arrow between the web browser 208 and the network 204. The web browser 208 connects the user's computer to an Internet site associated with the remote processing capabilities. This site transmits a web page to the browser, which displays a suitable window or text entry box via which the user can identify a file to submit for processing using traditional Hypertext Transfer Protocol (HTTP), for example, and by using a TCP/IP connection to either a network such as a LAN, WAN, VPN, or the Internet”</i> [emphasis added].</p>
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OTHER ISSUES

The Board of Patent Appeals and Interferences is a review body, rather than a place of initial examination. We have made a rejection above under 37 C.F.R. § 41.50(b). We leave it to the Examiner to determine the appropriateness of any further rejections based on the James reference (U.S. Pat. 6,742,161) alone or in combination with any other prior art references.

DECISION

We affirm the Examiner's rejection of claims 1, 6-9, 12, 13, 16, and 21-23, but we reverse the Examiner's rejection of claims 2-5, 10, 11, 14, 15, 17-20, and 24. Therefore, the decision of the Examiner rejecting claims 1-24 is AFFIRMED-IN-PART.

We have entered a new grounds of rejection for independent claim 17 under 37 C.F.R. § 41.50(b).

As indicated *supra*, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that "A new ground of rejection . . . shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the

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proceeding will be remanded to the
examiner . . .

- (2) *Request rehearing.* Request that the
proceeding be reheard under § 41.52
by the Board upon the same record . . .

No time period for taking any subsequent action in connection with
this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b).

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